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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,813	09/08/2003	Chang-Chih Sung		2877

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EXAMINER

TARAZANO, DONALD LAWRENCE

ART UNIT PAPER NUMBER

1773

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/658,813

Applicant(s)

SUNG, CHANG-CHIH

Examiner

D. Lawrence Tarazano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-7 is/are pending in the application.
- 4a) Of the above claim(s)    is/are withdrawn from consideration.
- 5) ☐ Claim(s)    is/are allowed.
- 6) ☒ Claim(s) 1 and 4-7 is/are rejected.
- 7) ☐ Claim(s)    is/are objected to.
- 8) ☐ Claim(s)    are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on    is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No.   .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, and 4-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicants claim “a method for preventing a light guide plate from being distorted” by applying protective films on the opposite sides of the structure. The films are “plastic”; however, there are no examples of the materials, which can function in this capacity. It is not clear how one could practice the claimed invention. The applicants give no guidance in the selection of the materials used. Furthermore, as far as claim 2 goes, it is not clear what type of “polymer” layer the applicants are using which hydrophilic on ones side and hydrophobic on the other.

### ***Response to Arguments***

1. Applicant's arguments filed 1/11/06 have been fully considered but they are not persuasive.
2. The applicants state that the desirable of the attributes of the plastics will guide the choice of materials and cites 4, 936,473 as an example of a patent reciting a barrier material. First, all

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of the documents cited by the applicants should have been provided on a PTO-1449 (Information Disclosure Statement). None of the documents were provided.

3. The examiner pulled a copy of the above patent. It is to a "Hot-Fill Product Container with Multi-Layer Wall Structure". It is unclear how this patent would give any guidance to someone working in the "wave or light guide" art. This is clearly non-analogous art, which is not solving any of the problems facing the applicant for a "removable protective coating". Had the examiner cited this patent in a rejection, the applicants could have clearly berated him for citing non-analogous art.

4. The examiner maintains that it is unclear what type of materials would be suitable; one working in the art would be relegated to trial and error. While the applicants state that "moisture barrier" properties are desirable for the material, this is neither clearly claimed nor is the required level of moisture barrier necessary clearly presented.

5. Additionally, these films have to be removable. What would be appropriate means for removal, peeling? Washing? Wiping?

6. What about a peelable layer of polymer? (What sort of peel strength would be suitable not to damage the substrate?) What sort of polymers would provide the desired protection?

7. How about using a layer of water-soluble polyvinyl alcohol, which is washed off? Would these leave undesirable residues?

8. For example would a coating of silicone oil, which is applied and then wiped off work, or would this not have enough moisture barrier properties or leave undesirable residues?

9. The applicants wish to obtain the right to exclude others from practicing the claimed invention. This right should not be taken lightly. These claims are so broad that one has no idea

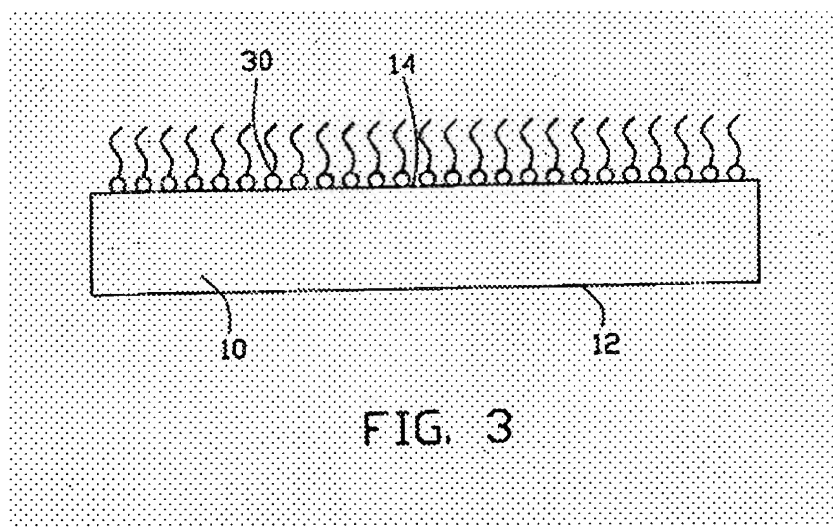
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how to practice the invention. If one was trying to determine a case infringement, one has no guidance as to determine what applicants intended as their invention and what they actually invented.

10. As far as the polymeric coating, which is applied after the protective coating is removed the applicants state that it would be clear what type of polymers they intend which have hydrophobic and hydrophilic properties.

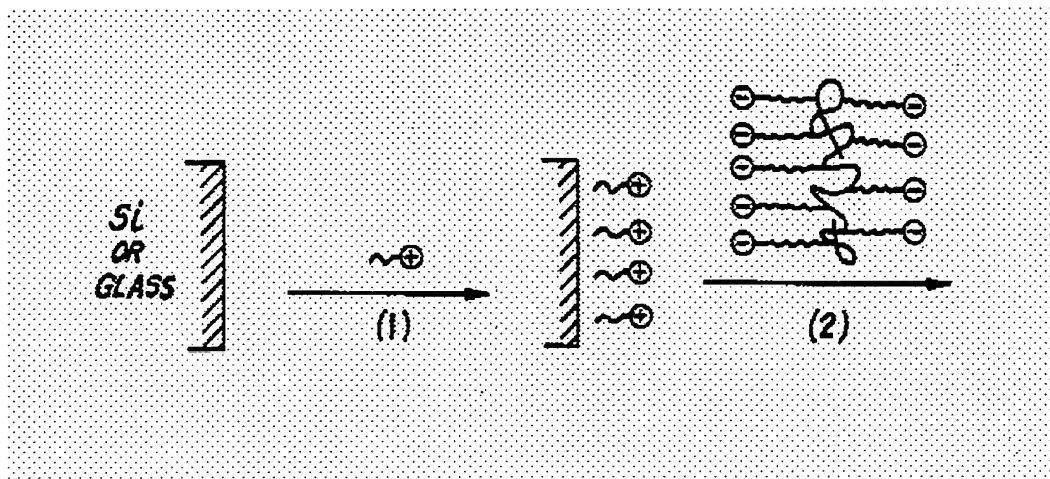
11. There are a number of interpretations of the claimed invention; it could be a single polymer, which phase separates. It could also be a multilayer structure. The applicants have not made it clear what they intended at the time the invention was made.

12. Additionally, the representation of the coating (30) in figure 3 is troubling. This coating does not appear to be polymeric from the general representation. In most instances, this type of drawing is representative of monolayer molecular coating having a polar tail and non-polar tail.



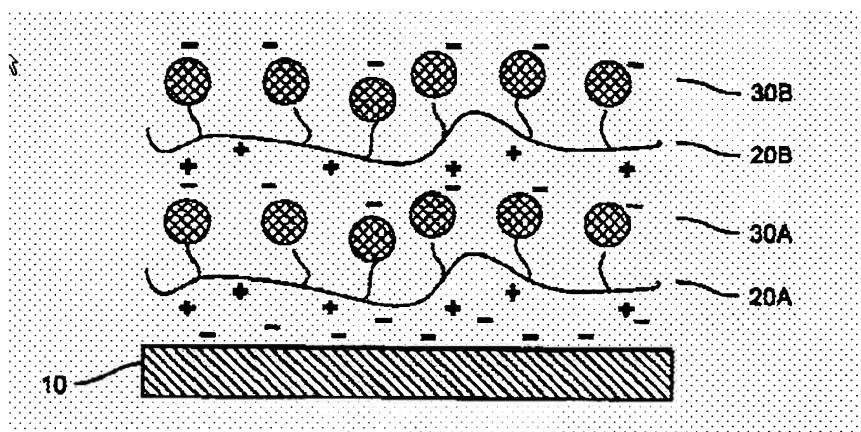
13. It is known in the art to both coat articles with rows of molecules and layers of polymers. This type of coating can be seen side by side in (5,208,111).

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14. It appears that (1) is most like the applicants' representation, but this is not a polymeric material. It represents single molecules with divergent heads and tails. The polymeric coating (2) is a charged moiety, but is very clear from the representation that it is polymeric.

15. This is also true for (6,953,607), in which (30) is a polymeric coating having different properties.



16. Given the limited disclosure of the applicants' submission, the examiner does not feel that the applicants have given sufficient guidance as to determine how to practice the claimed invention. He has reviewed both the applicants' response and the original filed papers; however, the issues surrounding this application remain unclear.

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17. The applicants may wish to file a CIP application, which includes examples of suitable materials and/or working examples so as to give clear guidance of what the current claims cover.

***Conclusion***

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Lawrence Tarazano whose telephone number is (571)-272-1515. The examiner can normally be reached on 8:30 to 6:00 (off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571)-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. Lawrence Tarazano  
Primary Examiner  
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A handwritten signature in black ink, appearing to be 'DLT' or similar, enclosed within a hand-drawn oval shape.